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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD F. HAMILTON and MICHAEL D. ROSEN

Appeal 2007-3091
Application 08/777,958
Technology Center 2600

Oral Hearing Held: February 14, 2008

Before ANITA PELLMAN GROSS, MAHSHID D. SAADAT, and JOHN A. JEFFERY, Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

CHARLES HIEKEN, ESQUIRE
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The above-entitled matter came on for hearing on Thursday, February 14, 2008, commencing at 9:03 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia, before Janice A. Salas, Notary Public.

1 THE CLERK: Calendar Number 18, Mr. Hieken.

2 MR. HIEKEN: Good morning, Your Honors. May it please the
3 Board, this is an appeal from the final rejection of claims 1, 3 through 6, 8
4 through 10 directed to an audio speaker system in a vehicle as nonenabling
5 and indefinite; claims 1, 3, and 4 as anticipated by a May 1991 article in Car,
6 Audio, and Electronics and unpatentable over a May '91 article in view of a
7 Bazooka brochure describing the Bazooka loudspeaker; and finally, claims
8 1, 3 through 6, and 8 through 10 as unpatentable over the March 1991 article
9 in view of the Bazooka.

10 I'd like to discuss the enablement and indefiniteness only briefly. The
11 prior art -- and there's additional evidence that you have here, which is very
12 unusual, of an e-mail having been sent to Bose competitors seeking
13 information which they hoped to use in connection with rejecting the claims
14 and turned up not a single bit of evidence.

15 In terms of the enabling and the indefiniteness, we submit that that
16 was decided in prior appeals in this case, and anyway, even if it wasn't, if
17 you just look at it as what is involved in connection with this particular
18 invention, it's just putting a small loudspeaker driver in the rear of the trunk,
19 preferably in a corner where it takes up negligible trunk volume and
20 produces good bass.

21 And one of the things that was discovered by the Bose inventors,
22 which is described in the application, is that at certain frequencies that there
23 was an unusual peak in one portion of the automobile and a dip in another
24 portion, these frequency ranges, and when you put this small loudspeaker in
25 the corner, why, that problem is omitted.

26 Now, as I said at the previous hearing, this is not the type of an

1 automobile loudspeaker system that's going to have the same characteristics
2 as, for example, the Bose system in the latest Cadillac CTS, but what it does
3 do is it give an automobile manufacturer an opportunity to provide
4 customers of the smaller and less expensive cars with good bass
5 inexpensively, and in this day and age, why, automobile manufacturers are
6 looking to the best they can to cut their costs.

7 And now the problem that a company like Bose faces when they don't
8 have patent protection, they're reluctant to make a presentation to an
9 automobile company of the invention because no sooner does it get out
10 there, then the competitors come in and want to use it.

11 Well, so let's look at what is in the disclosures in the prior art. If you
12 look at the March 1991 article in Car and Audio -- now, they happen to refer
13 to these articles as the Ziffer articles.

14 It happens that Amy Ziffer is the author who wrote the article rather
15 than having anything to do with what is disclosed in them, and both of these
16 articles relate to specially designed loudspeaker or audio systems for a
17 particular car, and they just don't meet or make obvious the claims of the
18 invention.

19 If you look at the March 1991 article -- that's the one of the Volvo that
20 they have in there, and if -- my copy is not very good and maybe your copy
21 is better, but what it does show is it shows those big Bazooka loudspeakers
22 in the trunk of the vehicle, which can't possibly anticipate the limitations of
23 the claims where the claims require that these loudspeaker drivers that you
24 put in be small enough so that they don't take up appreciable space.

25 Now, if you want to know what the Bazooka looks like, one of the
26 references that they cited is they show that Bazooka arrangement in the

1 trunk. It says small sedans, and you can see that they take up a good portion
2 of the trunk space. Cannot meet the limitations of the claims.

3 JUDGE SAADAT: Mr. Hieken --

4 MR. HIEKEN: Yes.

5 JUDGE SAADAT: -- with respect to the claim language, the
6 requirement is that in the trunk -- the speaker occupy negligible useful trunk
7 volume.

8 MR. HIEKEN: Correct.

9 JUDGE SAADAT: The examiner interpreted that as quite a relative
10 term. How much is negligible and why wouldn't Bazooka speakers, with
11 respect to the claim requirements as far as the placement of the speaker at
12 the rear of the trunk and so forth, wouldn't it meet the claim limitations?

13 MR. HIEKEN: Well, it has been described in the application as best
14 we could in terms of words. In addition, if you look at the figures, I think 5,
15 6, and 7, we have shown you what is meant by negligible volume.

16 In particular, even if you look at the -- I think it's fig 1 where you see
17 where the driver is put in there. It's in that far corner where it won't interfere
18 with putting bags in.

19 But look at this with these Bazookas in there. That's going to take up
20 a lot of trunk space from the standpoint of putting bags in, and what you're
21 required to do in terms of defining the invention is define it with reasonable
22 particularity so that those skilled in the art will know the difference between
23 infringing and noninfringing conduct.

24 And one of the nice things about having cited those references is that
25 those skilled in the art know that they can put something in -- put Bazookas
26 in the trunk without --

1 JUDGE SAADAT: Well, the drawing that we are referring to in this
2 reference, the one-page Bazooka reference, shows the placement of the
3 speakers pretty much similar to the placement that's described in the spec
4 over the rear base and there's -- it seems like there's enough space in the
5 middle, and another luggage or other cargo pieces could be placed in there.

6 MR. HIEKEN: No. No, Your Honor. Respectfully disagree that that
7 takes up substantial space in the trunk; whereas, we have tried to make it as
8 clear as we can in terms of the description that you put it in the -- as shown
9 there, in the preferred arrangement, in a rear corner of the trunk.

10 Where those Bazooka speakers are located, you could put probably
11 two bags in there. You can't do that with the Bose system where you put the
12 small driver in the corner. You still have your full -- virtually the full --
13 well, you do have -- you have the full usable trunk volume to use for storing
14 your bags or whatever it is you want to put in the trunk.

15 JUDGE SAADAT: Now, mind you, the type of vehicle is not part of
16 the claim. What if these Bazooka speakers are placed in a larger car, then
17 relatively, they would occupy negligible volume.

18 MR. HIEKEN: Not -- not true, Your Honor, because even in a larger
19 car, as we have defined the invention and we've -- and Phillips says you
20 interpret the claims in the light of the specification and the description, and I
21 don't know how we can describe it with any greater particularity than saying,
22 even in a larger car, if you put these big Bazookas in there -- if I put it in the
23 big Cadillac CTS, that would take up trunk space that was usable, but it
24 wouldn't if we take that little tiny driver and put it in there.

25 Of course in the CTS we aren't interested in that, but in the smaller
26 sedans where -- the lower cost ones, that's an area where we think we can do

1 something useful.

2 That's one of the things that you sit up and you're dealing with paper
3 all the time and you don't realize how important patents are to manufacturers
4 in an industry like this where it's very competitive and where I think Bose
5 has been designing special sound systems for cars since 1983.

6 This is what we've been trying to do, better sound, and trying to do it
7 at reasonable and low cost, and at this stage we have yet to offer this
8 invention through a manufacturer, and so we think it's -- we've defined it as
9 best we can, and that's all we're supposed to do I think, and for small drivers,
10 it's not obvious.

11 Well, one of the things, looking at this Bazooka article, it says, "Holes
12 for mounting speakers in the rear deck can be left open and covered with a
13 cosmetic grille which will allow the bass to enter the vehicle more freely."

14 So saying that that -- as what it teaches. If anything, it teaches away
15 from the invention of having -- of at least those claims of the invention
16 where we say the rear deck has no holes in it.

17 JUDGE SAADAT: Which claim are you talking about? Claim 1?

18 MR. HIEKEN: I'm sorry?

19 JUDGE SAADAT: Claim 1?

20 MR. HIEKEN: No. Claim 1 doesn't claim it, but I think in dependent
21 claims we talk about having no holes or we talk about the property where
22 you avoid -- you avoid the peak and dip at certain frequency ranges in the
23 front and rear seats.

24 JUDGE SAADAT: Okay.

25 MR. HIEKEN: That's clearly -- there's no disclosure of that in any of
26 the prior art, and as I -- and now --

1 JUDGE SAADAT: Well, Bazooka doesn't require a hole. It says, "It
2 can be left open."

3 It's not a requirement. It's an optional item.

4 MR. HIEKEN: That is correct, Your Honor, but even so, if you look
5 at what is section 103, which is what we're testing it at, the statute says, "If
6 the differences between the prior art and the subject matter sought to be
7 patented are such that the subject matter as a whole would not have been
8 obvious to a person of ordinary skill at the time the invention was made."

9 Well, that subject matter as a whole embraces, shall we say, not only
10 the structure but principles of operations, problem solved. If none of the
11 prior art discloses the problem, how can one say that the subject matter as a
12 whole would have been obvious at time that is a solution.

13 And if you look at what the examiner's arguing, he's saying here, well,
14 the Bazooka was the smallest speaker available at the time for bass response.

15 So if he's saying that the Bazooka is the smallest speaker available at
16 the time of the invention, then how can you say that it's obvious that a small
17 speaker, a small little driver put in the trunk in that rear corner out of the
18 main baggage space and producing reasonably good bass for the listeners
19 would have been obvious at the time the invention was made.

20 It simply doesn't -- just doesn't follow. And now, look at what the
21 examiners did. I have never seen -- I've been practicing patent law for over
22 50 years.

23 I have never seen a situation where an e-mail was sent around to
24 competitors of an application owner looking for prior art. That seems to me
25 to be evidence that the examiners themselves realized that the art that they
26 had was not good enough to sustain a rejection under section 103.

1 JUDGE JEFFERY: Counsel, is this e-mail in the record?

2 MR. HIEKEN: Yes, it is, and it -- it went out to 67 people, and they
3 said in there that well, it doesn't relate to an application that you have
4 pending, but in fact one of the recipients was Mitch Nollman of Bose
5 Corporation at Bose.com who fortunately handled it over to us so we could
6 see it.

7 JUDGE SAADAT: Is that how you found out about it?

8 MR. HIEKEN: Yes. That's how we found out about it.

9 JUDGE SAADAT: And did you raise that concern with the director?

10 MR. HIEKEN: I raised it with the solicitor. The solicitor was
11 outraged at what was happening also, but also in there you find not only are
12 there competitors, you'll find one, say, addressed to H. Sperlin who was a
13 former sales manager of Bose and who is now at a competitor, Harman
14 International.

15 And not only was it sent to competitors of Bose, but it was sent to our
16 competitors, two law firms, Wolf Greenfield in Boston and Hale and Dorn in
17 Boston, and so that is further evidence that you can use to support that the
18 conditions for patentability have been met.

19 I know my time is about up, and if there are no further questions --

20 JUDGE GROSS: Any questions?

21 JUDGE JEFFERY: I do have one final question here. The claim calls
22 for negligible useful volume in the trunk. That these speakers take up
23 negligible useful volume.

24 You know, I'm looking at Bazooka. I just want to return to that again.
25 Are you saying that those speakers are not taking up negligible useful
26 volume? Isn't that a subjective term?

1 I mean, what's useful to one person may or may not be useful to
2 another. Isn't that -- I mean, notwithstanding, I know you've described what
3 this means in the specification and the like, but isn't that a subjective term,
4 though, in the end of the day?

5 MR. HIEKEN: No. No more than, say, where you have, like, the
6 term substantially and all, and if you look at -- I know there's some federal
7 circuit cases where they say, look, you -- is all you're required to do is define
8 it as best you can so that those skilled in the art know the difference between
9 infringing and non-infringing conduct.

10 And it's pretty clear from the description that you would never put that
11 Bazooka in the corner, the small corner, where we've tried to illustrate it or
12 where it would fit in any of those areas.

13 So, as I said, that by citing that, these references, the examiners have
14 done a service by saying to people, if you want to put Bazookas in the trunk,
15 you're free to do it. This patent would never cover it.

16 Thank you very much.

17 JUDGE GROSS: Thank you.

18 MR. HIEKEN: And thank you for letting me come in first. Really
19 appreciate it.

20 (Whereupon, the proceedings at 9:24 a.m. were concluded.)